

REMARKS

This application has been carefully reviewed in light of the Office Action of September 21, 2006, wherein:

- A. The Examiner requested that the Applicants amend the cross-referenced applications paragraph on page 1 of the specification;
- B. Claims 1-3, 6-8, 10-13, 15, 16, 23-25, and 29-30 were rejected under 35 USC 102(b) a being clearly anticipated by US Patent No. 6,137,802 to Jones; and
- C. Claims 4-5, 9, 14, 17-22, 26-28, and 31-32 were rejected under 35 USC 103(a) as being unpatentable over US Patent No. 6,137,802 to Jones, in view of US Patent No. 6,304,851 to Kmack.

Examiner's Requests

- A. On page 2 of the Office Action, the Examiner requested that the Applicants amend the first paragraph on page 1 of the specification to reflect the continuation record for US App. No. 10/794,203. During a telephone conference with the Examiner and the Applicants' representative, Sarah Guichard, on October 25, 2006, it was discovered that the continuation record for US App. No. 10/794,203 was in error. As explained in the telephone conference, and shown in Appendix A, US App. No. 10/794,203 is a CIP of 10/774,079, 10/773,394 and 10/773,487. Since 10/774,079, 10/773,394, and 10/773,487 are all related applications and filed on the same day (2/6/2004), they are not CIPs of each other. Therefore, the Applicants submit that the first paragraph of the specification is correct as previously amended.

Claim Rejections – 35 U.S.C. §102

- B. Claims 1-3, 6-8, 10-13, 15, 16, 23-25, 29 and 30 were rejected under 35 USC 102(b) a being clearly anticipated by US Patent No. 6,137,802 to Jones, herein referred to as the "Jones patent."

Regarding Claim 1

Claim 1 claims, in part, “a configurable port for connecting an edge device; and a processor for executing an application running on the network switch, for allowing an administrator to selectively configure the port to support either a wired edge device or a wireless edge device.”

In the office action, the Examiner continued to reject Claim 1. On page 2 of the office action, the Examiner responded to the Applicants’ arguments in the previous response by stating “Jones’ ATM switch 12 is able to support either a wired edge device or a wireless edge device. In other words, Jones’ ATM switch was configured to have that capability. The configuration was done by a person using a configuration application program. The person is inherently called an administrator.” The Applicants respectfully disagree with the conclusions drawn by the Examiner.

In order to establish a *prima facie* case of anticipation, the Examiner must set forth an argument that provides (1) a single reference (2) that teaches or enables (3) each of the claimed elements (as arranged in the claim) (4) either expressly or inherently and (5) as interpreted by one of ordinary skill in the art. All of these factors must be present, or a case of anticipation is not met. As stated in the MPEP 2131, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). The Applicants submit that each and every element of Claim 1 is not found in the Jones patent.

First, the Examiner states that “[The] Jones’ ATM switch was configured to have that capability [the capability to support either a wired edge device or a wireless edge device]. The configuration was done by a person using a configuration application program.” The Examiner does not point to anywhere in the Jones patent where the Jones patent teaches, discloses, or suggests that the “configuration was done by a person using a configuration application program.” Instead, the Examiner makes the statement without referring to any portion of the Jones patent. The Applicants do not find any teaching or suggestion in the Jones patent to support the Examiner’s conclusion. If the Examiner continues to maintain his position that the Jones patent teaches “the configuration was done by a person using a configuration application program” the

Applicants respectfully request that the Examiner explain to the Applicants how he is interpreting the Jones patent to reach this conclusion.

The Applicants note that on page 2 of the current office action, the Examiner points to the Applicants own specification and drawings in support of his conclusion that the network switch disclosed in the Jones patent is configurable. The Applicants submit that Figure 1 of the Applicants' specification is not labeled as prior art. Therefore, the Applicants submit that the Applicants' specification cannot be combined with the Jones patent to anticipate the Applicants' claims. The Applicants submit that Claim 1 claims "a configurable port." The Applicants submit that just because the ATM switch disclosed in the Applicants' specification contains "a configurable port" and the block diagram of the overall system in Figure 1 of the Applicants' specification has some similar blocks as Figure 1 in the Jones patent does not mean that the ATM switch disclosed in the Jones patent also has "a configurable port."

Further, Claim 1 claims, in part, "a configurable port for connecting an edge device; and a processor for executing an application running on the network switch, for allowing an administrator to selectively configure the port to support either a wired edge device or a wireless edge device."

Claim 1 claims "a configurable port." The Applicants submit that the Examiner has not shown where in the Jones patent "a configurable port" is taught, disclosed, or suggested. In fact, the Applicants submit that the Jones patent does not teach, disclose, or suggest that the ATM ports are "configurable" at all. Figure 1 of the Jones patent discloses an ATM switch having three ports, two of the ports are connected to base stations 30 and 32, and one port is connected to a wired service medium 38. There is no suggestion in the Jones patent that the ports supporting the base stations 30 and 32 can be "reconfigured" to support the wired service medium 38 or vice versa.

Additionally, in the previous office action, the Examiner points to col. 2, lines 50-53 of the Jones patent as showing that "Jones teaches a network (Figure 1) having ports (ATM switch) that could be selectively configured to support either a wired edge device or a wireless edge device." Col. 2, lines 50-53 state "FIG. 1 is a functional diagram of an ATM network that may be accessed by both wired and wireless mediums, in accordance with the present invention." The Applicants note that nowhere in this section cited by the

Examiner is there a hint that the ATM switch disclosed by Jones has a “configurable port.” If the Examiner continues to maintain his position that the Jones patent teaches “a configurable port” the Applicants respectfully request that the Examiner explain to the Applicants how he is interpreting the Jones patent to reach this conclusion.

Additionally, Claim 1 claims “a processor for executing an application running on the network switch, for allowing an administrator to selectively configure the port to support either a wired edge device or a wireless edge device.” The Applicants submit that the Jones patent does not teach, disclose, or suggest this limitation.

The Examiner stated on page 2 of the current office action that “Jones’ ATM switch was configured to [support either a wired edge or a wireless edge device. ... The configuration was done by a person using a configuration application program.” The Examiner has provided no evidence to support his conclusion that the Jones patent teaches that the “ATM switch was configured ... [and] [t]he configuration was done by a person using a configuration application program.” If the Examiner continues to maintain his position that the Jones patent teaches that the “ATM switch was configured ... [and] [t]he configuration was done by a person using a configuration application program,” the Applicants respectfully request that the Examiner explain to the Applicants where in the Jones patent he believes this teaching is found.

Thus far the only evidence that the Examiner has offered to support his position is in the previous office action dated March 23, 2006, on page 3, where the Examiner stated that the application 40 of Figure 2 of the Jones patent allows an administrator to selectively configure (Figure 3) the port to support either a wired edge device or a wireless edge device. As argued in the Applicants’ previous response, the Applicants submit that the application shown in Fig. 2 does not reside on the ATM switch, but rather on a user device. “The present invention encompasses an automatic medium switching apparatus and method by which any of the user devices 16-28 may communicate with the backbone network 10 using either wired or wireless service mediums, and may switch between wired and wireless service mediums, in accordance with predetermined criteria for selecting and utilizing either a wired or wireless service medium,” (col.3, lines 42-49). “Referring to Fig. 2, a modified protocol stack for use with both wired and wireless communications or service mediums, in accordance with the invention, is illustrated,”

(col.. 3, lines 60-63). Additionally, the operation of the invention is described in col. 7, line 27 through col. 9, line 65, consistently refers to the actions of the “user device.” Therefore, the Applicants submit that the application shown in Fig. 2 resides on the user device and not on the ATM switch.

Further, the Applicants submit that there is no hint in the Jones patent that there is a software application running on the ATM switch that can configure the ports. As pointed out above, the Applicants submit that the Jones patent does not teach, disclose, or suggest “a configurable port.” Since, the Jones patent does not teach, disclose, or suggest “a configurable port” then it follows that the Jones patent does not teach, disclose or suggest “a processor for executing an application running on the network switch, for allowing an administrator to selectively configure the port to support either a wired edge device or a wireless edge device.”

Additionally, the Jones patent does not teach, disclose, or suggest that a port is “configurable.” However, assuming *arguendo* that the port on the ATM switch disclosed in the Jones patent is “configurable,” one possible scenario is that a hardware change in the ATM switch is necessary in order to connect a wireless edge device to a port which previously was connected to a wired edge device. Thus, in this case, the ATM switch disclosed by the Jones patent could be configured to support either a wired or wireless edge device; however, this configuration change (which requires a change in hardware) could not be accomplished by “a processor … executing an application … allowing an administrator to selectively configure the port,” as is claimed in Claim 1.

For the forgoing reasons, the Applicants submit that Claim 1 is patentable over the cited prior art.

Regarding Claims 2-9

Claims 2-9 depend on Claim 1. For the reasons provided above, the Applicants submit that Claim 1 is patentable over the cited prior art. Therefore, the Applicants submit that Claims 2-9 are also patentable over the cited prior art at least through their dependence upon an allowable base claim.

Claim 10

The Applicants note that the Examiner did not address the Applicants arguments regarding Claim 10 in the final office action. The Applicants respectfully request that if the Examiner continues to maintain his position regarding Claim 10, that the Examiner address the Applicants arguments' presented below.

Claims 10 claims, in part, "a software application for allowing a user to input configuration information associated with the port." As previously discussed, the software application disclosed by the Jones patent is not on the switch but resides on the user device. Therefore, the Applicants submit that the Examiner has failed to establish where in the Jones patent "a software application for allowing a user to input configuration information associated with the port" is taught, disclosed, or suggested. Therefore, the Applicants submit that Claim 10 is patentable over the cited prior art.

Claims 11-16

Claims 11-16 are dependent upon Claim 10. For the reasons given above, the Applicants submit that Claim 10 is patentable over the cited prior art. Thus, Claims 11-16 are also patentable over the cited prior art at least through their dependence upon an allowable base claim.

Regarding Claim 29

The Applicants note that the Examiner did not address the Applicants arguments regarding Claim 29 in the final office action. The Applicants respectfully request that if the Examiner continues to maintain his position regarding Claim 29 that the Examiner address the Applicants' arguments presented below.

Claim 29 claims, in part, "a network switch comprising: ... a memory for storing a software image executable by a wireless edge device." In rejecting Claim 29, the Examiner refers to Fig. 7 and states that a memory is inherent component to implement Figure 7. As previously noted, Figure 7 refers to operations that occur on the user device, see col. 7, lines 35-51. The Examiner has not pointed to anywhere in the Jones patent a "memory for storing a software image executable by a wireless edge device" is taught,

disclosed, or suggested. Therefore, the Applicant submit that Claim 29 is patentable over the cited prior art.

Regarding Claims 30-32

Claims 30-32 depend upon Claim 29. For the reasons given above, the Applicants submit that Claim 29 is patentable over the cited prior art. Therefore, Claims 30-32 are also patentable over the cited prior art at least through their dependence upon an allowable base claim.

Claim Rejections – 35 U.S.C. §103

C. Claims 4-5, 9, 14, 17-22, 26-28, and 31-32 were rejected under 35 USC 103(a) as being unpatentable over US Patent No. 6,137,802 to Jones, in view of US Patent No. 6,304,851 to Kmack.

Regarding Claim 17

Claim 17 claims, in part, “configuring the port to support either a wired edge device or a wireless edge device.”

In rejecting Claim 17, the Examiner stated “with respect to the first four steps of claim 17 and the claims directed to download configuration information to devices, Jones teaches claim combination set forth above. The Applicants respectfully disagree.

As stated in the MPEP 706.02(j), to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)

The combination of the Jones patent and the Kmack patent do not teach, disclose, or suggest all of the elements of Claim 17.

As stated above with respect to Claim 1, the Examiner has not shown where in the Jones patent a network switch having a configurable port. Therefore, the Examiner has not shown where in the Jones patent “configuring the port to support either a wired edge device or a wireless edge device,” is taught, disclosed, or suggested. Further, the Applicants submit that this limitation is not found in the Kmack patent. Thus, the Applicants submit that Claim 17 is patentable over the cited prior art.

Further, the Examiner stated in the previous office action that “Jones does not explicitly disclose that the device configuration information is downloaded from the network.” The Examiner then turns to the Kmack patent to teach this limitation. Claim 17 claims, in part, “downloading the configuration information to the edge device when the edge device is connected to the port.” In the previous office action, on page 4, the Examiner stated that “Kmack teaches devices being configured by configuration information downloaded from a network (see lines 6-8 of column 8 in Kmack).” Col. 8, lines 6-8 of the Kmack patent state “the appropriate configuration data can be generated and downloaded to the portable computing device 10 via a communication link 14.” The Applicants submit that a “portable computing device” is not an “edge device.” Thus, the Applicants submit that the Kmack patent does not teach, disclose, or suggest “downloading the configuration information to the edge device when the edge device is connected to the port, as is claimed in Claim 17. Therefore, the Applicants submit that Claim 17 is patentable over the cited prior art.

There is no motivation to combine the Jones patent with the Kmack patent.

The Jones patent is directed toward “the field of communication networks, and more particularly to a novel method and apparatus which permits automatic switching of a user device between wired and wireless service mediums of communication networks.” Jones patent, col. 1, lines 5-10. The Kmack patent is directed toward “time and motion studies, and more particularly, to collecting time and event data for time and motion studies.” Kmack patent, col. 1, lines 6-8. These two patents are related to two different

areas and problems. Therefore, there is no motivation to combine these teachings as their technical areas are not relevant to each other.

Additionally, the Examiner states in the previous office action that “if the devices of Jones [are] required to be configured, it would have been obvious from the teaching of Kmack to a person of ordinary skill in the art to download the configuration information to the devices of Jones so that the devices are able to [communicate] with the port.”

First, the Applicants submit that the Jones patent does not teach, disclose, or suggest that the base stations 30 and 32 need to be configured. The idea of configuring the base stations (i.e., edge devices) comes from the Applicants’ disclosure. The Applicants’ disclosure cannot be used to show motivation to combine. Therefore, the Applicants submit that there is no motivation to combine the Jones and Kmack patents.

Second, even if the base stations 30 and 32 need to be configured, the Applicants submit that absent the Applicants’ disclosure, it would not have been obvious to download the configuration information. As described in the Background of the Invention section of the Applicants’ patent application, on page 2, lines 23-26, “in known wireless LANs, each AP must be individually configured. ... A network administrator must configure each AP individually and then connect it to the network.”

Therefore, in light of the foregoing, the Applicants submit that there is no motivation to combine the Jones and Kmack patents.

The combination of the Jones and Kmack patents would not result in a system as Claimed in Claim 17.

The Kmack patent in col. 8, lines 6-8 states “the appropriate configuration data can be generated and downloaded to the portable computing device 10 via a communication link 14.” The Applicants submit that the portable computing devices 10 of the Kmack patent are most similar to the user devices 16, 18, 20, 22, 24, and 26 of the Jones patent. Therefore, assuming *arguendo* that the Kmack and Jones patent could be combined, their combination would result in teaching that the configuration of the user devices 16, 18, 20, 22, 24, and 26 could be obtained by downloading configuration data via a communication link. The Applicants submit that this is not the same thing as “downloading the configuration information to the edge device when the edge device is

connected to the port,” (emphasis added) as is claimed in Claim 17. Therefore, the Applicants submit that the combination of the Jones and Kmack patents would not result in the system as claimed in Claim 17.

Regarding Claims 18-22

Claims 18-22 depend on Claim 17. For the reasons give above, the Applicants submit that Claim 17 is patentable over the cited prior art. Thus, Claims 18-22 are patentable over the cited prior art at least through their dependence upon an allowable base claim.

Regarding Claim 23

Claim 23 claims, in part, “means for selectively configuring the connecting means to connect to either a wired edge device or a wireless edge device.” The same arguments presented above with respect to Claim 1 can also be applied to Claim 23. Therefore, the Applicants submit that Claim 23 is patentable over the cited prior art.

Regarding Claims 24 - 28

Claims 24-28 depend on Claim 23. For the reasons give above, the Applicants submit that Claim 23 is patentable over the cited prior art. Thus, Claims 24-28 are patentable over the cited prior art at least through their dependence upon an allowable base claim.

Concluding Remarks:

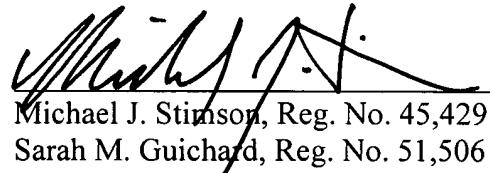
For all the foregoing reasons, reconsideration of and withdrawal of all outstanding rejections is respectfully requested. The Examiner is earnestly solicited to allow all claims, and pass this application to issuance.

The Applicants believe that no fees are owed in connection with this response. However, if any fee is in fact owing that is otherwise not accounted for, the Commissioner is hereby authorized to charge Deposit Account No. **08-3038**, (referencing Docket No. **02453.0021.NPUS00**) for the requisite fee. Additionally, if further extensions of time are required, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed. The petition fee due in connection therewith may be charged to deposit account no. **08-3038**.

To expedite allowance of this case, the Examiner is earnestly invited to call the undersigned at (949) 759-5269.

Respectfully submitted,

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